

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendments and in light of the following discussion, is respectfully requested.

Claims 23-37 are pending and amended. No new matter is introduced.¹

In the outstanding Office Action, Claims 23-37 were rejected under 35 U.S.C. § 112, first paragraph; Claims 23-37 were rejected under 35 U.S.C. § 112, second paragraph; Claims 23-26, 36 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs (U.S. Patent No. 6,226,618) in view of Floyd (U.S. Patent No. 6,243,692); and Claims 27-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs and Floyd in further view of Davis (U.S. Patent No. 6,105,008).

Initially, Claims 23, 36 and 37 are amended in conformance with the requirements of 35 U.S.C. § 112, first paragraph. Non-limiting support for this amendment may be found at least at page 3, lines 4-9. For example, periodic payment request is described. Accordingly, it is respectfully requested that the rejection of Claims 23-37 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Further, it is believed that the amendments to Claims 23-37 render the rejection of these claims under 35 U.S.C. § 112, second paragraph, moot.

In reply to the rejection of Claims 23-26 and 36-37 as being unpatentable over Downs in view of Floyd, Claim 23 is amended to recite, *inter alia*, a payment system for controlling continued use of a software program by a user, including:

a terminal configured to access software stored on a computer readable storage linked thereto, the terminal including

control means for *periodically determining a payment for continued use of the software* based on previous use of the software...(Emphasis added.)

¹ Non-limiting support for the amended claims may be found at least at page 2, lines 14-16 and page 3, lines 4-9 of the specification as originally filed.

At the outset, Applicants note that Claim 23, *inter alia*, defines a terminal that includes a control means recited in means-plus-function, terminology invoking 35 U.S.C. § 112, paragraph 6. MPEP § 2182 discusses construction of means-plus-function claim features. Specifically, MPEP § 2182 provides that

The first step in construing a means-plus-function claim limitation is to define *the particular function* of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 [58 USPQ2d 1801, 1806] (Fed. Cir. 2001)... The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 [68 USPQ2d 1263, 1267] (Fed. Cir. 2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 [43 USPQ2d 1896, 1900] (Fed. Cir. 1997)). (Emphasis added.)

As stated in MPEP §2182, functional claim language is central to the proper construction of features recited in means-plus-function terminology, and cannot be ignored or minimized as the outstanding Office Action contends.² Moreover, in rejecting Claim 23, and the claims depending therefrom, the outstanding Office Action provides none of the analysis required by the two-step analysis described in MPEP §2182. As such, it is believed that a *prima facie* case of obviousness has not been properly made.

Moreover, it is believed that no reference cited discloses or suggests the features of Claim 23 excerpted above.

Downs generally describes an electronic content delivery system in which a digital content store provides encrypted versions of digital content to a user.³ The content is then decrypted using a key provided to the user upon payment of a fee.⁴ However, as acknowledged on page 5 of the outstanding Office Action, Downs neither discloses nor

² See the outstanding Office Action at pages 2-3.

³ Downs at column 3, lines 40-45.

⁴ See, for example, Figure 9 of Downs.

suggests periodically determining a payment for *continued* use of the software. To remedy this deficiency in Downs, the outstanding Office Action combines Downs with Floyd.

Floyd generally describes a secure electronic software package that uses a setup-external unlocking module. Floyd describes creating a trial version of an application by integrating a trial module into the application.⁵ Specifically, a trial DLL is included into the trial version of the application in order to check for the presence of an unlocking DLL.⁶ The trial DLL then controls execution of the application according to a primary license file which, for example, specifies a 30-day trial unless the unlocking DLL is determined to be present.⁷ Thus, after expiration of the 30-day trial, the trial DLL will prevent further execution of the software unless the unlocking DLL is found.⁸

However, Floyd does not describe that the trial DLL periodically requires a new version of the unlocking DLL in order to permit continued use of the software. Instead, Floyd only describes that as long as the trial DLL determines that the unlocking DLL is present, use of the application is permitted.⁹ Floyd also describes that unlocking of the software occurs upon payment.¹⁰ In other words, Floyd merely describes a system of unlocking a trial application version by providing an unlocking DLL to the user of the application upon a single payment. Nowhere, however, does Floyd describe that additional unlocking DLLs and/or additional payments are required for continued use of the application once the application has been unlocked. Conversely, amended Claim 23 recites *periodically determining a payment* for continued use of the software. Therefore, Floyd fails to disclose the claimed control means and does not cure the above-noted deficiencies in Downs. As such, no combination of Downs and Floyd describes every feature recited in amended Claim

⁵ Floyd at column 3, lines 15-31.

⁶ Floyd at column 3, lines 52-67.

⁷ Floyd at column 4, lines 8-11.

⁸ Floyd at column 4, lines 15-18.

⁹ Floyd at column 3, lines 52-67.

¹⁰ Floyd at column 2, lines 35-41.

23, and amended Claim 23 is believed to be in condition for allowance, together with its corresponding dependent claims.

Moreover, amended Claims 36-37 recite features substantially similar to those recited in amended Claim 23 and are believed to be in condition for allowance for substantially similar reasons. Accordingly, it is respectfully requested that the rejection of Claims 23-26 and 36-37 under 35 U.S.C. § 103(a) be withdrawn.

As all other rejections of record rely upon Floyd for describing the above-distinguished features, and the above-distinguished features are not disclosed or suggested by Floyd, alone or in combination with any other art of record, it is respectfully submitted that a *prima facie* case of obviousness has not been presented. Accordingly, it is respectfully requested that the rejection of Claims 27-35 under 35 U.S.C. § 103(a) be withdrawn.

For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 23-37 is earnestly solicited.

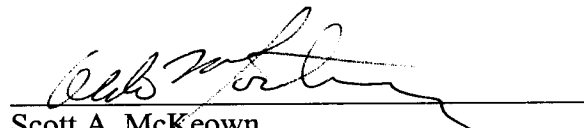
Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/09)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Scott A. McKeown
Attorney of Record
Registration No. 42,866

Aldo Martinez
Registration No. 61,357